

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

CALLAWAY GOLF COMPANY,

Plaintiff,

v.

ACUSHNET COMPANY,

Defendant.

C. A. No. 06-91 (SLR)

**DECLARATION OF ROLF HILLE IN SUPPORT OF
PLAINTIFF CALLAWAY GOLF COMPANY'S OPPOSITION
TO DEFENDANT ACUSHNET COMPANY'S MOTION TO
STAY LITIGATION PENDING *INTER PARTES*
REEXAMINATION BY THE U.S. PATENT OFFICE**

I, Rolf Hille, declare as follows:

1. I am Director of Practice Systems for Fish & Richardson P.C., counsel of record in this action for Callaway Golf Company. Prior to joining Fish & Richardson, I spent 30 years working for the United States Patent and Trademark Office in various capacities including patent examiner, patent program specialist, supervisory patent examiner, and Technology Center Director. I have personal knowledge of the matters stated in this declaration and would testify truthfully to them if called upon to do so.
2. Since the *inter partes* reexamination process was established in 1999, there have been just over 140 *inter partes* requests filed. I analyzed every single one of these filings by examining the transactional history of each of the cases to determine how quickly these applications make their way through the Patent and Trademark Office (PTO). Specifically, I analyzed the transaction history for each of the *inter partes* reexaminations filed to date using the Patent Application Information Retrieval (PAIR) system maintained by the PTO.

3. Based upon my review, it takes the PTO almost a year and a half to issue an action closing prosecution, which means the examiner's decision is final and the case is ripe for appeal to the Board of Patent Appeals and Interferences (BPAI). However, even for those applications which are not appealed, it takes almost two years on average for the PTO to issue a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC), which is a notice that the examiner must complete upon conclusion of the *inter partes* reexamination proceeding. Some *inter partes* reexaminations have taken more than three years just to get a NIRC – even without an appeal.

4. If appropriate, at this time, an examiner's amendment will also be prepared. For each claim that is found patentable, reasons must be given as to why. In addition, the examiner must prepare the reexamination file so that the Office of Publications can prepare and issue a certificate, in accordance with 35 U.S.C. 316 and 37 C.F.R. 1.997, setting forth the results of the reexamination proceeding and the content of the patent following the proceeding.

5. If however, a party decides to appeal the PTO's decision following the close of prosecution (see paragraph 3 above), the process takes much longer. Before actually filing the appeal to the BPAI, it generally takes another four months from the close of prosecution for the PTO to issue a right of appeal notice so that the patent owner can exercise its first layer of potential appeals.

6. The next step from here would be to appeal any decision to the BPAI. From my review, it takes almost three years from granting a request for *inter partes* reexamination to have the issue ripe before the BPAI, which is the first avenue of appeal. Only two cases of the 147 *inter partes* reexaminations filed to date are before the BPAI at this time. The BPAI has not issued a decision in either of those cases.

7. The next level of review would be an appeal to the Federal Circuit Court of Appeals. To date, no decisions have made it to the stage where they are ripe for appeal to the Federal Circuit Court of Appeals.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed this 18th day of May, 2006, at Washington D.C..



Rolf Hille

CERTIFICATE OF SERVICE

I hereby certify that on May 19, 2006, I electronically filed **DECLARATION OF ROLF HILLE IN SUPPORT OF PLAINTIFF CALLAWAY GOLF COMPANY'S OPPOSITION TO DEFENDANT ACUSHNET COMPANY'S MOTION TO STAY LITIGATION PENDING *INTER PARTES* REEXAMINATION BY THE U.S. PATENT OFFICE** with the Clerk of Court using CM/ECF which will send electronic notification of such filing(s) to the following Delaware counsel. In addition, the filing will also be sent via hand delivery:

Richard L. Horwitz
David E. Moore
Potter Anderson & Corroon LLP
Hercules Plaza, 6th floor
1313 N. Market Street
Wilmington, DE 19801

Attorneys for Defendant
ACUSHNET COMPANY

I hereby certify that on May 19, 2006, I have mailed by United States Postal Service, the document(s) to the following non-registered participants:

Joseph P. Lavelle
Andrew R. Sommer
Howrey LLP
1299 Pennsylvania Avenue, N.W.
Washington, DC 20004

Attorneys for Defendant
ACUSHNET COMPANY

/s/ Thomas L. Halkowski
Thomas L. Halkowski